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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Hironori Sato

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EXAMINER

FAISON GEE, VERONICA FAYE

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

07/23/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/572,738	Applicant(s) SATO ET AL.	
	Examiner VERONICA FAISON GEE	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 18-20 and 31-33 provides for the use of magenta ink, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 18-20 and 31-33 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6-8, 12-33 are rejected under 35 U.S.C. 102(b) as anticipated by WO 2004/039900 (US 2005/0041082 is being used as the English Translation).

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The reference teaches an ink set comprising a yellow ink, a magenta ink, cyan ink and red ink (abstract, 0023). The reference further teaches that the yellow ink comprising 2 to 4% by weight of Pigment Yellow 74, the magenta ink comprising 1.7 to 3% by weight of Pigment Violet 19, the cyan ink comprising 0.5 to 2.5% by weight of Pigment Blue 15:3 (0026-0029). The ink set L^* values for aqueous solution of each ink is diluted 1000 times are within the ranges of yellow ink (Y): at least 89 and no more than 94, magenta ink (M): at least 76 and less than 83, cyan ink (C): at least 74 and no more than 87 (0044-0046). The a^* and b^* values for the magenta ink are in the range a^* : 31 to 51, b^* : -17 to -10. (0050). The reference teaches that a dispersant may be used to disperse the pigments of the ink set (0075). The ink compositions further comprise a high boiling organic solvent including glycerin present in the amount of 0.1 to 30% by weight (0081-0082). The penetration promoter is present in the amount of 1 to 20% by weight (0083-0084). A surfactant including acetylene glycol compound or a silicone compound is present in the amount of 0.01 to 5% by weight (0085). The reference further teaches that photoback and/or matte black ink may be used in the ink set (0154, 0156, 0160). The reference discloses a recording method, a recording system and a recorded mater (0151-0153, 0176-0179). The reference remains silent to an ink cartridge. However, the ink set is tested using a PM900C ink jet printer, which has ink cartridges as evidenced by US 2004/0246321 paragraph 441 that discloses that the printer PM900C wherein the ink set is charged in the cartridge. The reference does not disclose L^* value is 60 or less. However, the L^* , a^* and b^* are properties of the colorant and then the ink composition is measure in the same environment that the L^* ,

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a* and b* value would be the same as claimed by Applicant. The composition as taught by WO 2004/039900 appears to anticipate the claimed invention.

Claims 1-8 and 12-16 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 2005-120310.

JP 2005-120310 teaches an ink composition comprising a polymer dispersing agent, water-insoluble color material, a water-soluble organic solvent and water (abstract).

The water-insoluble color material is a pigment including Pigment Yellow 74, Pigment Violet 19 and 32 and Pigment Blue 15:3 present in the amount of 0.1 to 20% by mass (abstract, 0008, 0018, 0019). The polymers dispersing agent is present in the amount of 0.1 to 20% by mass (0027). The water soluble organic solvent such as glycerin and is present in the amount of 5 to 50% by mass (0031-0032). The reference further teaches that various additives such as surface-active agent, pH adjuster, an antioxidant and an antifungal agent may be added to the ink composition (0033). See production of the ink M-5 and M-6 (0155-0159). The reference remains silent to the CIE properties. However, the composition of the reference is identical to the claimed composition and identical composition must have the same properties. See MPEP 2112.01 I. For these reasons, the composition of the reference is presumed to inherently possess the claimed properties. The composition as taught by JP 2005-120310 appears to anticipate the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 2004/039900 in view of JP 2005-120310.

WO 2004/039900 is described above, but fails to teach Pigment Violet 32.

JP 2005-120310 is described above.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have replaced Pigment Violet 19 with Pigment Violet 32 because the substitution of art recognized equivalents as shown by JP 2005-120310 would have been within the level of ordinary skill in the art.

With respect to claim 10 and 11, it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose... [T]he idea of combining them flows logically from their having been individually taught in the prior art. *In re Kerkhoven*, 626 F. 2d 846, 850, 250 USPQ 1069, 1072 (CCPA 1980). See MPEP 2144.06.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERONICA FAISON GEE whose telephone number is (571)272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.A. LORENZO/

Supervisory Patent Examiner, Art Unit 1793

/Veronica Faison-Gee/

Examiner, Art Unit 1793